

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 45

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE TASH

Appeal No. 2005-2543
Application 08/637,894

ON BRIEF

Before KIMLIN, WARREN, and TIMM, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the supplemental answer mailed March 25, 2005, and appellant, in the brief and the reply brief to the supplemental answer filed May 6, 2005,¹ and based on our review, find that we cannot sustain the grounds of rejection advanced on appeal: appealed claims 1, 2, 6 and 9 under 35 U.S.C. § 102(b) as anticipated by Scarella (supplemental answer, pages 4-5);² and appealed claims 1, 2, 6 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Scarella and Tash as applied in the ground of rejection set forth at pages 5-6 of

¹ The supplemental answer was filed in response to our remand entered August 9, 2004, in Appeal No. 2004-1604 in this application, and appellant filed the reply brief in response.

² Appealed claims 1, 2, 6 and 9, set forth in the appendix to the brief, are all of the claims remaining in the application after entry of the amendment of May 6, 2005, canceling claims 3, 4

the supplemental answer, further in view in Locke (supplemental answer, pages 6-7).³

Our consideration of the grounds of rejection requires that we initially interpret representative appealed independent claim 1 by giving the terms thereof the broadest reasonable interpretation in their ordinary usage as they would be understood by one of ordinary skill in the art in light of the written description in the specification, including the drawings, as interpreted by this person, unless another meaning is intended by appellant as established in the written description of the specification, and without reading into the claims any limitation or particular embodiment disclosed in the specification. *See, e.g., In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). The plain language of claim 1 encompasses a drain plunger comprising at least, among other limitations, drain hole sealing rings comprising at least the specified three sealing rings. We note here that the open-ended term “comprising” used in transition and in the body of the claim opens the claim to include drain plungers having any manner of additional materials and elements. *See, e.g., Vehicular Technologies Corp. v. Titan Wheel Int’l Inc.*, 212 F.3d 1377, 1383, 54 USPQ2d 1841, 1845 (Fed. Cir. 2000); *In re Baxter*, 656 F.2d 679, 686-87, 210 USPQ 795, 802-03 (CCPA 1981).

The first or upper sealing ring is annular, curved, depending from the lowermost portion of the bellows and cooperates with that part of the bellows to form a first drain seal. The at least curved ring depends from, that is, hangs down from, the lower most portion of the bellows in a manner such that this arrangement forms an air-tight seal with a drain hole, and encompasses the structure shown by bellows 22 bottom portion 30 of pleats 34 and top seal 32 in specification **Fig. 3** (specification, page 6, ll. 25-26, and page 8, ll. 5-12). We determine that one of ordinary skill in the art would recognize from the structure shown in specification **Fig. 3** that the term “depending from” is used in its ordinary, dictionary meaning in context of “[t]o hang down from.”⁴

and 10 through 17. Claims 8 and 9 are also of record and have been held by the examiner to be drawn to allowable subject matter (final action mailed April 9, 2003; page 5).

³ None of the remaining appealed claims are rejected under 35 U.S.C. § 103(a) over Scarella and Tash in the ground of rejection set forth at pages 5-6 of the supplemental answer.

The second sealing ring is bulbous, annular, curved, depending from the first ring and located relative to the first ring to form on its outer surface a second seal smaller than the first seal. The at least curved ring must in addition be bulbous, that is, it must have a bulb-like rounded projection, and depend from, that is, hangs down from, the first sealing ring in manner that the surface of the second ring forms an air-tight seal smaller than the first seal, thus encompassing the structure shown by seal 36 in specification **Fig. 3** (specification, page 8, ll. 14-17). We determine that one of ordinary skill in the art would recognize from the structure shown in specification **Fig. 3** that the term “bulbous” is used in its ordinary, dictionary meaning in context of “[r]esembling a bulb in shape; rounded or swollen.”⁵

The third bottom sealing ring is secured to, that is, attached to, the underside of the second seal, smaller in diameter than the second seal, and the outer surface forms a third air-tight seal, thus encompassing the structure shown by seal 38 in specification **Fig. 3** (specification, page 8, ll. 18-24).

The language of claim 1 further provides that the sealing rings are “integral with the lower end” of the bellows and are “integral with each other and said bellows.” We determine that the term “integral” requires that the sealing rings and the bellows are joined together in any manner to form a complete structure, which structure is also specified by the “depending from” and “secured to” language in the seal limitations.

We cannot agree with the examiner’s position in the ground of rejection of appealed claim 1 as anticipated by Scarella, that the three ribs 7 and the cylindrical portion 8 of cone 6 shown in Scarella **FIG. 1** describe a structure that falls within the three sealing structure required by claim 1. While the ribs 7 and cylindrical portion 8 are annular and curved with respect to cone 6, the structure shown in the Scarella **FIGs. 1 and 3** does not satisfy the requirements of claim 1 as we have interpreted this claim above. This is because the first and second ribs 7 are not “depending from” the bellows 5 and then each other; the first rib 7 does not cooperate with

⁴ See, e.g., *The American Heritage Dictionary, Second College Edition* 382 (Boston, Houghton Mifflin Company, 1982); *Webster’s II New Riverside University Dictionary* 363 (Boston, Houghton Mifflin Company, 1988).

⁵ See, e.g., *The American Heritage Dictionary, Second College Edition* 215 (1982); *Webster’s II New Riverside University Dictionary* 207 (1988).

the lowermost section of the bellows 5 to form an air-tight seal; the second rib 7 cannot be characterized as “bulbous;” and there is no evidence in either the disclosure of Scarella or in the FIGs. thereof, that any or all of the ribs 7 form an air-tight seal. Indeed, as appellant points out (brief, e.g., pages 6-7; reply brief, pages 1-3), while ribs 7 are disclosed “for anchoring” and form a part of the outer part of cone 6, there is no disclosure that any or all of the ribs 7 *per se* form an air-tight seal when “cone 6 inflates slightly, and its outer part adheres against the inside of the trap, it takes on its shape and creates a seal” (Scarella, page 5, l. 19, to page 6, l. 4). We do not arrive at a different result by considering cylindrical portion 8 of cone 6, and indeed, the examiner does not explain how cylindrical portion 8 changes the relationship of ribs 7 to the limitations of the appealed claims.

Thus, we find as a matter of fact that Scarella FIG. 1 and the disclosure with respect thereto in the reference does not describe each and every limitation of appealed claims 1, 2, 6 and 9, arranged as required by the claims in a manner sufficient to have placed a person of ordinary skill in the art in possession of the claimed drain plunger within the meaning of § 102(b), and therefore, we reverse this ground of rejection. *See generally, In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78, 7 USPQ 1315, 1317 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

In the ground of rejection of appealed claim 1 as obvious over the combined teachings of Scarella and Locke,⁶ the examiner relies on Locke “which discloses an analogous plunger which includes continuous seals 12,” holding that it would have been obvious “to associate continuity with the Scarella rings seals [*sic*] in order to facilitate drain engagement” (supplemental answer, pages 6-7). In response to appellant’s arguments in the brief (see pages 11-12), the examiner

⁶ In the ground of rejection based on Scarella and Tash (*see above* note 3), the examiner relied on Tash solely for the disclosure of “an analogous plunger which further is plastic (col. 2 ln. 64 and col. 3 lns. 1-2)” to hold that it would have been obvious to “associate plastic with the Scarella plunger” (supplemental answer, pages 5-6). None of the appealed claims have a “plastic” limitation and, on this basis, we find it unnecessary to discuss Tash with respect to this ground of rejection.

further argues that Scarella “discloses three ring-shaped seals 7 (and at 8),” and that “all of the seals 12 (at least three) in Locke are ‘bulbous annular curved shaped’ (like those in Scarella) as illustrated in Fig. 1, albeit closer in visual appearance to the seals disclosed by appellant” (*id.*, page 7).

Appellant states in the brief that “Locke teaches a drain cleaning device having a cup (3) with a side wall portion (11) that . . . forms a series of annular corrugations (12), which exhibits progressively smaller diameters towards the bottom of the device” and “allow its lower end to be wedged into a drain opening to seal it when water pressure is applied (see Col. 2, lines 69-79 and lines 105-109)” (pages 11-12). Appellant submits “that Locke, while perhaps teaching a continuous series of seals does not teach the claimed three sealing ring configuration with its bulbous annular curved shaped second sealing ring” (*id.*, page 12). Appellant further submits in the reply brief, that there is no motivation to modify the drain plunger of Scarella with the corrugated structure of Locke (page, 3).

We cannot agree with appellant that side wall **11** of cup **3** as shown in Locke **Fig. 1**, falls outside of the seal ring arrangement specified in appealed claim 1 because the second of the series of annular, corrugations **12**, which are smaller in diameter in the lower edge than in the upper portion, as described at page 1, ll. 69-79, is not “bulbous” as specified. Indeed, we find that each of the corrugations **12** can be characterized as having a bulb-like rounded projection, which falls within this term. In this respect, we find no basis in either the language of appealed claim 1 or in the written description in the specification, including specification **Figs. 3 and 5**, to read the shape of the second seal ring shown in the specification figures into the claim as a limitation. Furthermore, Locke discloses that the lower end of the corrugations **12** can be wedged into a drain, as shown in Locke **Fig. 4**, either by the internal pressure created by water in the cup or by conically tapered head **6** being wedged into the cup, thus causing the cup walls to clamp and hold against the drain, forming a seal preventing leakage (page 1, ll. 77-79, and page 2, ll. 4-17).

However, the examiner has not provided a showing establishing that objective teaching, suggestion or motivation in the applied prior art or knowledge generally available to one of ordinary skill in the art would have led that person to substitute the corrugations **12** of Locke for

cone 6 of Scarella because we find little, if any, structural similarity between these two structures for essentially the reasons we discussed above for holding that cone 6 of Scarella did not satisfy the requirements of the seal rings specified in appealed claim 1. The fact that one of ordinary skill in this art can so modify the plunger of Scarella does not alone provide the motivation to do so. *See In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Accordingly, in the absence of a *prima facie* case of obviousness, we reverse the ground of rejection of appealed claims 1, 2, 6 and 9 under 35 U.S.C. § 103(a) over Scarella, Tash and Locke.

The examiner's decision is reversed.

Remand

We remand the application to the examiner for consideration of issues raised by the record. 37 CFR §1.41.50(a)(1) (September 2004); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 2, May 2004; 1200-29 – 1200-30).

We find that Tash discloses a drain plunger in, among others, **Fig. 1**, showing sealing ring or rim **38** attached to bellows **14** and ring **42** depending from sealing ring or rim **38**, wherein ring **42** can have skirt **52** depending therefrom which acts as a seal as shown in **Fig. 4**, sealing the plunger in a drain (e.g., col. 3, ll. 1-39, col. 3, l. 57, to col. 4, l. 9). We further find that the drain plungers disclosed by Tash differ from the plungers encompassed by appealed claim 1 in the absence of "the bulbous curved second seal" as pointed out by appellant in the brief (page 10).

We found above that the side wall **11** of cup **3** with the series of annular, corrugations **12**, which are smaller in diameter in the lower edge than in the upper portion and the second of the series can be characterized as having a bulb-like rounded projection, as disclosed by Locke satisfies the requirements for the sealing rings in appealed claim 1.

Thus, the examiner should consider whether one of ordinary skill in this art would have found in the combination of Tash and Locke, as well as in any other reference developed by the examiner, the motivation to modify the drain plunger of Tash by replacing the part thereof containing sealing ring or rim **38** and ring **42** with corrugated side wall **11** of cup **3** of Locke in

view of the structural relationship between the sealing rings of Tash and of the annular, corrugations 12 of Locke in the reasonable expectation of obtaining additional sealing rings to seal the end of the plunger to a wide range of drain holes.

We point that our consideration of the appealed claims vis-à-vis the combined teachings of Tash and Locke involves materially different factual considerations than those involved with the examiner's grounds of rejection based on Scarella and Tash, with and without Locke, to which appellant has not had an opportunity to respond. *See generally, In re Eynde*, 480 F.2d 1364, 1370-71, 178 USPQ 470, 474-75 (CCPA 1973); MPEP § 1213.02 (8th ed., Rev. 2, May 2004; 1200-32).

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to consider whether a new ground of rejection should be entered on the record based on the above findings under either 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a) as the examiner deems appropriate, for purposes of further prosecution of the appealed claims, supplying and applying any other applicable prior art with respect to any or all of these grounds as the examiner deems appropriate.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application, by virtue of its “special” status, requires immediate action. *See* MPEP § 708.01(D) (8th ed., Rev. 2, May 2004; 700-127). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case. *See, e.g.,* MPEP§ 1211 (8th ed., Rev. 2, May 2004; 1200-30).


REVERSED

REMANDED



EDWARD C. KIMLIN

Administrative Patent Judge



CHARLES F. WARREN

Administrative Patent Judge



CATHERINE TIMM

Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

Appeal No. 2005-2543
Application 08/637,894

Lyon & Harr, LLP
300 Esplanada Drive
Suite 800
Oxnard, CA 93036